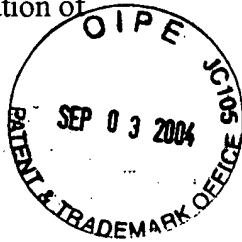


IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re U.S. Patent Application of
Williams
Serial No. 10/051,488
Filed: January 18, 2002
For: **Multipurpose Foldable Candle Tool**
Attorney Docket No. 4818-002



Hadi Shakeri
Examiner
Group: 3723

Raleigh, North Carolina
August 31, 2004

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

APPLICANT'S REPLY BRIEF

I. The Examiner Expressly Held That a Section 1.132 Declaration Could Not Be Used to Traverse a 102 Rejection

In the final office action the Examiner was very clear with respect to the Section 1.132 Declaration. The Examiner held that:

The Declaration under 37 CFR 1.132 filed 06/06/03 is insufficient to overcome the rejection of claims 1-7, 10, 15-17 and 20 since an Affidavit/Declaration submitted under 37 CFR 1.132 for the purpose of traversing grounds of rejection does not apply to rejections under 35USC102(b), anticipation, as is the case here, over US Patent No. 4,238,862, however, in view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness. (emphasis added)

The language in the Examiner's holding is clear. The Examiner states that a Section 1.132

Declaration does not apply to rejections under 35 U.S.C. §102(b). However, the Examiner goes

on to correctly state that a Section 1.132 Declaration could be used to rebut an obviousness rejection.

It appears now that the Examiner takes the position that the Section 1.132 Declaration was considered for purposes of the 102(b) rejection. With all due respect, this cannot be the case. The Examiner's handling of the Section 1.132 Declaration as discussed in the final office action is clear. The Examiner concluded that a Section 1.132 Declaration is not appropriate and cannot be used to overcome a 102 rejection. That was error. The Examiner should not be permitted to attempt to correct this deficiency in its brief. It is too late.

The Examiner's Answer does not deal at any significant length with the substance of Mr. Williams' Declaration. Mr. Williams' Declaration as discussed in Applicant's opening brief clearly rebuts the anticipation position taken by the Examiner. Not a single fact stated in Mr. Williams' Declaration stands rebutted. The only rebuttal is argument advanced by the Examiner.

II. Mr. Williams And The Prosecution History Clearly Disclaims Any Construction of the Claims That Would Cover The Leatherman Prior Art.

The Examiner in one sentence suggests that Applicant did not further limit the claims by this disclaimer. Applicant respectfully disagrees. Disclaimers that are clear and unambiguous have a limiting affect. The disclaimer made in this case certainly precludes the claims from being construed to cover the cited prior art.

An inventor can disavow or disclaim scope of coverage by making a representation that clearly disavows claim scope. See, e.g., *Texas Digital Systems, Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1204 (Fed. Cir. 2002). This is precisely what Mr. Williams, the inventor, has done in this case. The disclaimer is clear and it expressly and unambiguously disclaims and disavows any scope of his claims that would cover any one of the tool devices incorporated into the Leatherman patent.

The Examiner has not seriously addressed the disclaimer, nor has the Examiner cited any authority that holds that such a disclaimer is ineffective.

III. The Examiner's "Capable Of" Argument Did Not Form The Basis For The Rejection of a Majority of the Claims During Prosecution.

It appears now that the Examiner is relying upon a "capable of" argument to support the rejection of many of the claims.


In the Examiner's Answer, as well as the final rejection, claims 1, 2, 4-7, 10, 15, 16 and 20-23 stand rejected as being anticipated by Leatherman. In rejecting these claims under Section 102, the Examiner does not take the position in the Answer or the final office action that the functional limitations of the claim are met because the prior art is "capable of" performing the recited functions. *Examiner's Br.* at 3, 4. The Examiner uses the "capable of" argument only with respect to claims 8 and 19. *Examiner's Br.* at 4. The Examiner has acknowledged that the PTO is not relying on the doctrine of inherency. *Examiner's Br.* at 7.

Thus, the rejection of claims 1, 2, 4-7, 10, 15, 16, 20-23 under Section 102(b) stand or fall based on the cited art, that is the patent to Leatherman, explicitly showing all limitations, structural and functional, of the claimed invention. The Examiner cannot rely on inherency or "capable of" theories to support its 102 rejections.

Respectfully submitted,

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CERTIFICATE OF MAILING

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Kathyl Stahl

DATE: 8/31/2004